

ESTTA Tracking number: **ESTTA642103**

Filing date: **12/02/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following parties oppose registration of the indicated application.

### Opposers Information

Name	John Paul Uceda
Granted to Date of previous extension	12/03/2014
Address	165 Summit Avenue 2nd Floor Hackensack, NJ 07601 UNITED STATES

Name	Mario Uceda
Granted to Date of previous extension	12/03/2014
Address	6745 Caporetto Lane Las Vegas, NV 89084 UNITED STATES

Name	Doris Uceda
Granted to Date of previous extension	12/03/2014
Address	752 Allwood Road Clifton, NJ 07012 UNITED STATES

Name	Juan J Uceda
Granted to Date of previous extension	12/03/2014
Address	10063 Mooreshire Circle Orlando, FL 32829 UNITED STATES

Name	Ines Uceda
Granted to Date of previous extension	12/03/2014
Address	752 Allwood Road Clifton, NJ 07012 UNITED STATES

Name	Charo Uceda
Granted to Date	12/03/2014

of previous extension	
Address	415 Vineland Staten Island, NY 10312 UNITED STATES

Attorney information	Arthur R. Lehman Arthur R. Lehman LLC 52 Vanderbilt Avenue New York, NY 10017 UNITED STATES arthur@lehmanlawyer.com Phone:212 697-2715
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## Applicant Information

Application No	86233150	Publication date	08/05/2014
Opposition Filing Date	12/02/2014	Opposition Period Ends	12/03/2014
Applicant	UCEDA INSTITUTE, INC. 111 Ellison St Paterson, NJ 07505 UNITED STATES		

## Goods/Services Affected by Opposition

Class 041. First Use: 1992/04/15 First Use In Commerce: 1993/04/15  
All goods and services in the class are opposed, namely: Education services, namely, providing classes and tutorials in the fields of english as a second language (ESL), citizenship preparation, computer proficiency, and test preparation, language instruction

## Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

## Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	UCEDA		
Goods/Services	Educational services, namely, conducting classes, seminars, conferences, workshops in the field of English as a second language, language instruction, and college preparation and distribution of course materials in connection therewith in printed or electronic format; providing test preparation and English language programs and services to non-native speakers; and providing housing information and other student services.		

Attachments	Notice of Opposition to File.pdf(207802 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address

record by First Class Mail on this date.

Signature	/Arthur R. Lehman/
Name	Arthur R. Lehman
Date	12/02/2014

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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JUAN J. UCEDA, INES UCEDA,  
CHARO UCEDA, DORIS UCEDA, JOHN  
PAUL UCEDA, and MARIO UCEDA,

Opposition No.

Opposers,

**NOTICE OF OPPOSITION**

vs.

UCEDA INSTITUTE, INC.,

Applicant,  
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Application Serial Number: 86233150  
Mark opposed: Uceda Institute  
Filing Date: March 26, 2014

Juan J. Uceda, whose address is 10063 Mooreshire Circle, Orlando, Florida 32829; Ines Uceda, whose address is 752 Allwood Road, Clifton, New Jersey 07012; Charo Uceda, whose address is 415 Vineland, Staten Island, New York 10312; Doris Uceda, whose address is 752 Allwood Road, Clifton, New Jersey 07012; John Paul Uceda, 165 Summit Ave., 2<sup>nd</sup> Floor, Hackensack, New Jersey 07601; and Mario Uceda, 6745 Caporetto Lane, Las Vegas, Nevada 89084 (collectively, the “Opposers”), by their undersigned attorney, hereby oppose registration of the mark “Uceda Institute” in International Class 041 for, among other things, education services, namely, providing classes and tutorials in the fields of English as a second language (ESL), citizenship preparation, computer proficiency, test preparation, and language instruction, which is the subject matter of Application Serial Number 86233150, filed on March 26, 2014 by Uceda Institute, Inc., a New Jersey corporation.

As grounds for their opposition, the Opposers state as follows:

1. Juan J. Uceda was the founder and sole owner of Uceda English Institute, Inc., a school principally engaged in teaching English as a second language to non-native speakers. Juan J. Uceda opened the school on May 12, 1988 and incorporated it under the laws of the State of New York on April 28, 1989. He has used the name "Uceda" continuously since 1988 and founded, among other entities, Uceda Institutes in West New York, New Jersey; Manhattan, New York; Elizabeth, New Jersey; Brooklyn, New York; Hackensack, New Jersey; Lake Worth, Florida; Union City, New Jersey; Orlando, Florida; Charlotte, North Carolina; and Las Vegas, Nevada. Juan J. Uceda has not abandoned the use of the name "Uceda" in connection with English language schools.

2. Charo Uceda is a daughter of Juan J. Uceda. She was a Co-Founder and worked with Juan J. Uceda in the original Uceda English Institute in 1988. Charo Uceda has used the name "Uceda" continuously since 1988 in English language institutes in Elizabeth, New Jersey; North Newark, New Jersey; Harrison, New Jersey; West Orange, New Jersey; Freeport, New York; and Charlotte, North Carolina; and Boca Raton, Florida. Between 1989 and 1991, Charo Uceda wrote a set of four textbooks for use in teaching English as a second language between 1989 and 1991, under the name "Charo Uceda English Series." Charo Uceda has not abandoned the use of the name "Uceda" in connection with English language schools.

3. Doris Uceda is a daughter of Juan J. Uceda. She was a Co-Founder and worked with Juan J. Uceda in the original Uceda English Institute in 1988. Doris Uceda currently uses the name "Uceda" in operating an English language school in North Plainfield, New Jersey. Doris Uceda has not abandoned the use of the name "Uceda" in connection with English language schools.

4. Ines Uceda is the former wife of Juan J. Uceda. In 2006, Ines Uceda acquired Uceda English Center, Inc., a corporation that operated an English language school in Brooklyn, New York, from Juan J. Uceda. Juan J. Uceda founded that school in 1997 and operated it until the transfer in 2006. Also in 2006, Ines Uceda acquired Uceda English Institute of New Jersey, Inc., a corporation that operated an English language school in West New York, New Jersey, from Juan J. Uceda. Juan J. Uceda founded and operated that school from 1988 until the transfer in 2006. Ines Uceda has not abandoned the use of the name “Uceda” in connection with English language schools.

5. John Paul Uceda is a son of Doris Uceda. He acquired Uceda School of Hackensack, Inc. from Juan J. Uceda in 2001 and has used the name “Uceda” continuously since then in connection with English language schools, and acquired Uceda School of Union City, New Jersey from Juan J. Uceda in 2009. John Paul Uceda has not abandoned the use of the name “Uceda” in connection with English language schools.

6. Mario Uceda is a son of Doris Uceda. He has used the name “Uceda” continuously since 2008 in English language schools in Las Vegas, Nevada. Mario Uceda has not abandoned the use of the name “Uceda” in connection with English language schools.

7. Carlos Uceda is a son of Juan J. Uceda and, on information and belief, is the owner of the Applicant. Carlos Uceda did not become involved with the Uceda schools until 1993, at the earliest, when Juan J. Uceda gifted two schools to him. In the application that is the subject of this Opposition, the Applicant indicates that its first use of the Mark in commerce was April 15, 1993.

8. Each of the Opposers believes that he or she will be damaged if the Mark is registered, and each has a direct and personal stake in this proceeding. The Applicant has created

widespread confusion with respect to the relationship and affiliation between the schools operated by the Opposers and the schools operated by the Applicant. Carlos Uceda has misleadingly suggested that he is one of the founders of the Opposers' group of Uceda schools. In 2013, Carlos Uceda falsely claimed to have been involved in operating English language schools since 1988 (25 years) although he was not involved in any way in the schools until 1993 when Juan J. Uceda gifted two schools to Carlos Uceda. The Opposers have substantial goodwill in their use of their surnames in connection with their operation of English language schools, and the Opposers fear that if the Mark is registered, Applicant will seek to limit their ability to expand the reach of their schools and use their own surnames in the future.

9. The Opposers intend to apply for a trademark for the name "Uceda" in connection with the operation of English language schools, but fear that if the Applicant's Mark is registered, that registration would serve as a bar to registration by the Opposers.

10. Applicant's Mark for educational services is highly similar or identical to the Opposers' common law marks. The respective services for which the marks are used are virtually identical, and the same group of potential consumers would use the services of the Opposers and the Applicant. The Opposers have priority of use of their mark; they either founded a school using the mark before the Applicant began using the Mark, or acquired the school from one who had used the Uceda name in connection with English language schools before the Applicant began using the Mark.

11. The Applicant's Mark, "Uceda Institute," so resembles a mark or trade name previously used in the United States by the Opposers and not abandoned, as to be likely, when used on or in connection with services described in the Applicant's application, to cause confusion, mistake, or deception for purposes of 15 U.S.C. §1052(d).

WHEREFORE, the Opposers respectfully request that this Opposition be sustained and that the registration to Applicant be refused.

Dated: December 2, 2014

Respectfully submitted,

ARTHUR R. LEHMAN, L.L.C.

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Attorneys for Juan J. Uceda,  
Ines Uceda, Charo Uceda,  
Doris Uceda, John Paul Uceda and Mario  
Uceda

# CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing NOTICE OF OPPOSITION has been served on this 2<sup>nd</sup> day of December, 2014 to the correspondence address of record of the United States Patent and Trademark Office by mailing said copy on December 2, 2014, via First Class Mail, postage prepaid, to:

Nikki Siesel  
Law Offices of Joseph C. Messina  
424 Mamaroneck Avenue  
Mamaroneck, New York 10543

And by sending the foregoing NOTICE OF OPPOSITION by email on December 2, 2014 to [nsiesel@trademarklawesq.com](mailto:nsiesel@trademarklawesq.com), the email address provided for authorized communications.



Arthur R. Lehman